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EXAMINER
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LINDSEY, MATTHEW S

ART UNIT	PAPER NUMBER
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4152

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03/26/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/710,361	<b>Applicant(s)</b> GLIDDEN ET AL.	
	<b>Examiner</b> MATTHEW S. LINDSEY	<b>Art Unit</b> 4152	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 03 July 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 03 July 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>03 July 2004</u> .  | 6) <input type="checkbox"/> Other: _____                          |

## DETAILED ACTION

1. Claims 1-12 are pending in this application.

### *Claim Objections*

2. Claims 1, 2, 7, 12 are objected to because of the following informalities: the claims recite at least one instance of the word "recipient"s", several examples include in Claim 1, line 6, Claim 2, lines 5, Claim 7, third page, line 7, and Claim 12, line 5. Appropriate correction is required.

### *Claim Rejections - 35 USC § 112*

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. **Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.**

5. With respect to Claim 1, the claim recites the limitation "m. repeating h, i, and k using the first targets guessed email addresses in succession until j occurs or there are no other first recipient's guessed email addresses" (Claim 1, second page, lines 7-10).

This indicates the process stops at j, which is a step that monitors the response of the target recipient email server to determine if a bounce occurs, if the process stops at j there is no way to determine whether a bounce occurs or not, and hence no way to determine a valid email address.

Also, repeating steps h, i, and k indicate that the system repeats recording that an email address cannot be found if no bounce occurs, sending an email to the first guessed email address, and recording a valid email address if no bounce occurs.

These steps do not make sense since the first step records an email address cannot be found if no bounce occurs and the last step records a valid address if no bounce occurs.

Examiners interpretation of the specification indicates limitation "m." should read: "m. repeating i, j, and l using the first targets guessed email addresses in succession until k occurs or there are no other first recipient's guessed email addresses", and will be treated as such for the purposes of examination.

6. Further regarding Claim 1, the claim recites the limitation "o. repeating h, i, j, k and l using a second target recipient's guessed email addresses" (Claim 1, second page, lines 13-14). Steps h and k indicate that the system records that an email address cannot be found if no bounce occurs, and records a valid email address if no bounce occurs. These steps do not make sense because step h records no address can be found if no bounce occurs, and step k records a valid address if no bounce occurs.

Examiners interpretation of the specification indicates limitation “o.” should read: “o. repeating i, j, k, l, and m using a second target recipient’s guessed email addresses”, and will be treated as such for the purposes of examination.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

**7. Claim 12 is rejected under 35 U.S.C. 102(b) as being anticipated by Quine et al. (US 2002/0087647), hereinafter Quine.**

8. With respect to Claim 12, Quine discloses: “A system for determining an email address (Abstract, lines 1-3) comprising:

- a. means for obtaining the target recipient data items ([0053], lines 8-12);
- b. means for obtaining the target recipient’s email server address ([0007], lines 8-12);
- c. means for guessing a multiplicity of the target recipient’s possible email addresses ([0046], lines 1-11, where the address format compliance checker may provide several different outputs, specifically a suggested format for the email address, or specific changes may be suggested, or provide suggested alternative spellings);

d. means for testing the multiplicity of the target recipient's possible email addresses until a valid address is found ([0047], lines 7-10, where a forwarding service includes a correction routine and messages may have been previously found to be undeliverable, and the next email address guess will be sent)".

### ***Claim Rejections - 35 USC § 103***

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**10. Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over Quine, in view of Collins et al. (US 2002/0013817), hereinafter Collins, and further in view of "Setting up Catch All Email" (Setting up Catch All Email, October 5, 2002).**

11. With respect to Claim 1, Quine discloses: "A computerized method for determining a desired recipients email address (Abstract, lines 1-3) comprising:",  
"c. providing two or more first target recipient's data items ([0071], lines 7-10);  
d. guessing first target recipient's candidate email addresses from the unique email server address and data items ([0071], lines 10-19)",

“g. monitoring the response of the target recipient email server for the unique server address to determine if a bounce occurs ([0007], lines 17-21)”, and

“i. sending an email to the first target recipient’s first guessed email address ([0074], lines 8-9);

j. monitoring the response of the target recipient email server to determine if a bounce occurs ([0007], lines 17-21);

k. recording the valid email address if no bounce occurs ([0007], lines 15-21, which describes an unsuccessful attempt results in a bounce, implying a successful attempt will not result in a bounce);

l. sending a second email to the target recipient’s second guessed email address if a bounce occurs ([0047], lines 7-10, where the address correction routine is part of an email forwarding service and the message may have been previously found to be undeliverable);

m. repeating i, j, and l using the first targets recipient’s guessed email addresses in succession ([0047], lines 7-10, where the address correction routine is part of an email forwarding service and the message may have been previously found to be undeliverable, indicating a different email will be used) until k occurs ([0007], lines 15-21, which describes an unsuccessful attempt results in a bounce, implying a successful attempt will not result in a bounce, and after a successful result there is no need to continue guessing email addresses) or there are no other first recipient’s guessed email addresses ([0075], lines 7-10, where when there are no guesses for a correct email address a notification is sent to the user)”, and

“n. guessing second target recipient’s candidate email addresses ([0048], lines 3-6, where the software and data may be resident on a user’s personal computer, and invoked for any outgoing message. It is conceivable that an outgoing message may be addressed to multiple people, and thus the correction software would be implemented for a second target recipients email address);

o. repeating i, j, k, l, and m using a second target recipient’s guessed email addresses ([0048], lines 3-6, where the software and data may be resident on a user’s personal computer, and invoked for any outgoing message. It is conceivable that an outgoing message may be addressed to multiple people, and the software will operate on each identified email address)”.

Quine does not disclose: “a. choosing one or more target recipients;  
b. providing a unique email server address for each target recipient;  
e. developing a know invalid email address at the unique email server address;  
f. sending a probe email addressed to the known invalid email address;  
h. recording that the email address cannot be found if no bounce occurs”.

However, Collins discloses: “a. choosing one or more target recipients (Abstract, lines 1-2);  
b. providing a unique email server address for each target recipient ([0003], lines 1-5, and Figure 6, where the recipient list shows HEllis@jzgtr.net and Bkessel@sixstring.com, clearly indicating separate email server addresses)”.



It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the email delivery system of Quine with the teachings of Collins to include support for sending an email to multiple recipients having different email addresses. Motivation to combine these references comes from Collins where “Known e-mail programs permit a sender to transmit a message to multiple parties with only a single action” ([0008], lines 1-2). Therefore by combining the references, one can send a message to a plurality of parties with only a single action.

The combination of Quine and Collins does not disclose: “e. developing a know invalid email address at the unique email server address;  
f. sending a probe email addressed to the known invalid email address;  
h. recording that the email address cannot be found if no bounce occurs”.

However, “Setting up Catch All Email” discloses: “e. developing a know invalid email address at the unique email server address (pg 2, “Disabling your Catch All Feature”, lines 1-4, where a known invalid email address is developed using illegal syntax);  
f. sending a probe email addressed to the known invalid email address (pg 1, lines 5-10, where there is provided a catch all email, such that any message delivered to your domain will be routed to a certain email account and no messages will be bounced. Implicitly one will send a probe email to test if there is a bounce to determine if the domain employs a catch all email address);

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h. recording that the email address cannot be found if no bounce occurs (pg 1, lines 5-10, where there is provided a catch all email, such that any message delivered to your domain will be routed to a certain email account and no messages will be bounced. In such a situation, relying on a bounce to determine the incorrect email address of a target recipient will inherently fail because no bounce messages are returned”).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the email delivery system of Quine in view of Collins with the teachings of “Setting up Catch All Email” to include support for developing a known invalid email address, sending a probe email to the invalid address, and recording that an email address cannot be found if no bounce occurs. Motivation to combine these references comes from Setting up Catch All Email where: “The catch all is excellent if you have a high frequency of people whom mistype your email address, as these addresses (even though mistyped), will simply be bounced to your catch all or default email account” (pg 1, lines 5-6). Therefore by combining the references one can ensure delivery of emails even if people frequently mistype an email address.

**12. Claims 2-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Quine, in view of Jain et al. (US 7,203,706)**

13. With respect to Claim 2, Quine discloses: “A system to send email to target recipients (Abstract, lines 1-2) with known email server addresses ([0007], lines 3-12,

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where the sender knows the recipient works at Pitney Bowes and hence has an email server address of @pb.com) and with unknown email addresses ([0007], lines 10-12, where the sender guesses an incorrect address) comprising:

- a. a user interface ([0053], lines 8-12, where the routine sending an inquiry to the sender may "be resident on a user's personal computer" [0048], lines 3-4, and software on a computer which sends inquiries to users must have a user interface to function) operative to receive the desired target recipient's data items ([0053], lines 8-12, where the routine seeks further information about recipient), and to provide either the valid email address ([0057], lines 1-4) or a message that the email address could not be found to the user ([0075], lines 7-10);
- b. a target recipient's email server ([0007], lines 17-21, where the recipient's email server is the Pitney Bowes email server) operative with a known email server address ([0007], lines 3-12, where the sender knows the recipient works at Pitney Bowes and hence has an email server address of @pb.com) and providing a bounce message in response to an failed attempt to deliver an email with an incorrect address ([0007], lines 17-21, where the Pitney Bowes email server sends a message informing the original sender of the email, that the original message is undeliverable);
- c. an email address identifier send server ([0048], lines 6-9) connected to an email server networked with the target recipient's email server ([0048], lines 6-9, where it is inherent to function that the email server is networked with the recipient's email server) operative to guess a multiplicity of a target recipient's possible email addresses at the known domain name ([0046], lines 1-11, where the address format compliance checker

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may provide several different outputs, specifically a suggested format for the email address, or specific changes may be suggested, or provide suggested alternative spellings), based on the target recipient's data items ([0053], lines 5-10, where the system sends an inquiry to the user for the recipient's name, and uses the name to format the email address), to send email to the guessed email addresses sequentially as requested ([0047], lines 7-10, where the correction routine may be part of an email forwarding service and the message may have been previously found to be undeliverable, which indicates the forwarding service can receive sequentially failed attempts at delivery for the same target recipient and activate the correction routine for each subsequent attempt), and to determine if all guessed email addresses have been sent an email ([0075], lines 7-10);

d. an email address identifier read server ([0048], lines 6-9) connected to an email server networked with the target recipient's email server ([0048], lines 6-9, where it is inherent to function that the email server is networked with the recipient's email server) and operative to guess from the target recipient's data items a multiplicity of a target recipient's possible email addresses at the known domain name ([0046], lines 1-11, where the address format compliance checker may provide several different outputs, specifically a suggested format for the email address, or specific changes may be suggested, or provide suggested alternative spellings), to determine if a particular guessed email address has been sent an email by the email address identifier send server ([0047], lines 7-10, where a previous message may have been found undeliverable, indicating the email address used in the sent undeliverable message was

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incorrect), to identify a valid email address if no bounce message is received from the target recipient's email server ([0007], lines 15-21, which describes an unsuccessful attempt results in a bounce, implying a successful attempt will not result in a bounce), recognize a bounce message from the target recipient's email server ([0064, lines 12-22]), and to request the email address identifier send server send the next guessed email address an email upon receipt of a bounce message ([0047], lines 7-10, where the correction routine is part of a forwarding service and the message may have been previously found to be undeliverable), or identify the email address could not be found if all guessed email address have been sent an email by the email address identifier send server ([0075], lines 7-10)". Quine does not disclose: "a database server operative to maintain a record of results of the send server and read server operation".

However, Jain discloses: "a database server (Col. 1, line 66) operative to maintain a record of results of the send server and read server operation (Col. 1, lines 66-67)".

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the email address checking system of Quine with the teachings of Jain to include support for a database server that stores the results. Motivation to combine these references comes from being able to save processing time in future email address correcting routines in email messages sent to the same address that has already been checked and corrected, by storing the results in a database server the name or email can be searched for in the database. If the name or email is found in the database, the correction routine need not process syntax checking or generate email

address alternatives, thus saving processing time. Therefore by combining the references, one can save processing time of checking and correcting email addresses.

14. With respect to Claim 7, Quine discloses: "A system to send email to target recipients (Abstract, lines 1-2) with unknown email addresses ([0007], lines 10-12, where the sender guesses an incorrect address) and known data items ([0007], lines 3-6, known items including a recipients name and where the recipient works) and email server address ([0007], lines 3-12, where the sender knows the recipient works at Pitney Bowes and hence has an email server address of @pb.com) comprising:

- a. a database server ([0039], lines 2-6);
- b. an email server ([0048], lines 6-9);
- c. a target recipient email server ([0007], lines 17-21, where the recipient's email server is the Pitney Bowes email server) with a known address ([0007], lines 3-12, where the sender knows the recipient works at Pitney Bowes and hence has an email server address of @pb.com) and programmed to provide a bounce message in response to a request to deliver an email with an incorrect address ([0007], lines 17-21, where the Pitney Bowes email server sends a message informing the original sender of the email, that the original message is undeliverable);
- d. an email address identifier send server ([0048], lines 6-9) programmed to: receive a target recipient data items ([0071], lines 7-10) and a target recipient email server address ([0007], lines 3-12, where the sender knows the recipient works at Pitney Bowes and hence has an email server address of @pb.com), guess a multiplicity of

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possible email addresses from the target recipient data items and target recipient email server ([0046], lines 1-11, where the address format compliance checker may provide several different outputs, specifically a suggested format for the email address, or specific changes may be suggested, or provide suggested alternative spellings), send email through the email server to the guessed email addresses sequentially as requested ([0047], lines 7-10, where the correction routine may be part of an email forwarding service and the message may have been previously found to be undeliverable, which indicates the forwarding service can receive sequentially failed attempts at delivery for the same target recipient and activate the correction routine for each subsequent attempt),

e. an email address identifier read server ([0048], lines 6-9) programmed to: receive a target recipient data items ([0071], lines 7-10) and a target recipient email server address ([0007], lines 3-12, where the sender knows the recipient works at Pitney Bowes and hence has an email server address of @pb.com), guess a multiplicity of possible email addresses from the first and last name ([0086], lines 1-9, where email addresses are guessed using formatting rules and the first and last name of the recipient) and domain name ([0046], lines 1-11, where the address format compliance checker may provide several different outputs, specifically a suggested format for the email address, or specific changes may be suggested, or provide suggested alternative spellings), determine if a particular guessed email address has been sent an email by the email address identifier send server ([0047], lines 7-10, where a previous message may have been found undeliverable, indicating the email address used in the sent

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undeliverable message was incorrect), identify a valid email address if no bounce message is received from the target recipient email server ([0007], lines 15-21, which describes an unsuccessful attempt results in a bounce, implying a successful attempt will not result in a bounce), recognize a bounce message from the target recipient's email server ([0064, lines 12-22]), request the email address identifier send server send the next guessed email address an email upon receipt of a bounce message ([0047], lines 7-10, where the correction routine is part of a forwarding service and the message may have been previously found to be undeliverable), identify the email address could not be found on the database server ([0075], lines 1-4) if all guessed email address have been sent an email by the email address identifier send server ([0075], lines 7-10); and

f. a user interface ([0053], lines 8-12, where the routine sending an inquiry to the sender may "be resident on a user's personal computer" [0048], lines 3-4, and software on a computer which sends inquiries to users must have a user interface to function) programmed to provide the target recipient's data items ([0053], lines 8-12, where the routine seeks further information about recipient) and target recipient email server address ([0007], lines 3-12, where the sender knows the recipient works at Pitney Bowes and hence has an email server address of @pb.com) to the email address identifier send and receive servers ([0053], lines 8-14), and to receive either the valid email address ([0057], lines 1-4), or a message that the email address could not be found ([0075], lines 7-10)". Quine does not disclose: "record email sent on the database server".



However, Jain discloses: “record email sent on the database server (Col. 1, lines 66-67)”.

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the email address checking system of Quine with the teachings of Jain to include support for a database server that stores the results. Motivation to combine these references comes from being able to save processing time in future email address correcting routines in email messages sent to the same address that has already been checked and corrected, by storing the results in a database server the name or email can be searched for in the database. If the name or email is found in the database, the correction routine need not process syntax checking or generate email address alternatives, thus saving processing time. Therefore by combining the references, one can save processing time of checking and correcting email addresses.

15. With respect to Claims 3 and 8, the combination of Quine and Jain disclose: “further comprising the user interface is an Internet wide world web server with computer-executable instructions for email address identification (Quine, [0048], lines 7-10)”.

16. With respect to Claims 4 and 9, the combination of Quine and Jain disclose: “further comprising the user interface is a computer with computer-executable instructions for email address identification (Quine, [0048], lines 3-4)”.

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17. With respect to Claims 5 and 10, the combination of Quine and Jain disclose: “further comprising the user interface is a computer (Quine, [0048], lines 3-4) with computer-executable instructions for email address identification (Quine, [0048], lines 1-4, the correction routine may be performed on a computer) and with computer-executable instructions for maintaining an address book (Quine, [0082], lines 1-7)”.

18. With respect to Claims 6 and 11, the combination of Quine and Jain disclose: “further comprising the database server is a computer with computer-executable instructions (Jain, Col. 1, lines 66-67) for a database identifying potential (Quine, [0065], pg 7, lines 4-6, where the system holds a copy of the email in the event the intended recipient becomes known by the system in the future, indicating a potential customer may be recognized by the system in the future) and actual customers or clients (Quine, [0082], lines 1-9, where actual customers submit address book information)”.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MATTHEW S. LINDSEY whose telephone number is (571)270-3811. The examiner can normally be reached on Mon-Thurs 7:30-5, Alternate Fridays 7:30-4.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nabil El-Hady can be reached on (571) 272-3963. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

MSL  
3/20/2008

/Nabil El-Hady, PhD, M.B.A./  
Supervisory Patent Examiner, Art Unit 4152